

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed August 20, 2004 ("*Final Office Action*"). Claims 1-24 were pending in the Application and stand rejected. Applicants amend Claims 1, 4, 7, and 14. Applicants respectfully request reconsideration and favorable action in this case.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejects Claims 1, 2, 4, 5, 7-9, 14-16, and 21-24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,173,853, which issued to Kelly, et al. ("*Kelly*"), in view of U.S. Patent No. 5,731,813, which issued to O'Rourke, et al. ("*O'Rourke*").¹ The Examiner rejects Claims 3, 6, 10-13, and 17-20 under 35 U.S.C. § 103(a) as being unpatentable over *Kelly* in view of *O'Rourke*, and further in view of "Microsoft Word: User's Guide," 1993-1994, Version 6.0, p. 590-591 ("*Microsoft Corporation*"). To establish obviousness of a claimed invention under § 103, all claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03. Furthermore, there must be some teaching, suggestion, or motivation to combine or modify the teachings of the prior art to produce the claimed invention either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time of the invention. M.P.E.P. §2143.01.

A. *Kelly, O'Rourke, and Microsoft Corporation Fail to Teach or Suggest Each and Every Element of Claims 1-24.*

Applicants respectfully submit that *Kelly, O'Rourke, and Microsoft Corporation*, alone or in combination, fail to teach or suggest numerous elements of Claims 1-24. In general, *Kelly* discloses conversion of documents from a first document architecture to a second document architecture. More particularly, *Kelly* discloses conversion of documents from Compound Document Architecture to Open Document Architecture. In general, *O'Rourke* discloses a graphical user interface for organizing work on a computer. More

¹ The *Final Office Action* states that these claims are "rejected under 35 U.S.C. § 102(b) as being anticipated." *Final Office Action* at p. 3. However, the rejection is located below a section heading labeled "Claim Rejections - 35 USC § 103" and a quotation from 35 U.S.C. § 103(a). *Id.* at p. 2. Furthermore, the rejection involves two references, *Kelly* and *O'Rourke*.

particularly, *O'Rourke* discloses taking "snapshots" of computer screens when documents are loaded and using the snapshots as visual references for the documents. In general, *Microsoft Corporation* discloses using Microsoft Word to open documents created in other applications. More particularly, *Microsoft Corporation* discloses converting documents to Microsoft Word format when the documents are opened.

Applicants' independent Claim 1, as amended, recites:

A method, comprising the steps of:
providing a set of predetermined function definitions which are different, at least one of said predetermined function definitions defining a function for manipulating image data; and
preparing a project definition that is operable when executed to process said image data, said project definition including:
a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port of said function portion and at least one output port of said function portion that are functionally related according to the corresponding function definition;
a further portion which includes a source portion identifying a data source and defining an output port of said source portion through which said image data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port of said destination portion through which said image data can be supplied to the data destination; and
binding information which includes binding portions that each associate a respective one of said input ports with one of said output ports, at least one of said binding portions being a conditional binding which is responsive to a specified condition for associating a respective one of said input ports with one of a plurality of different said output ports that form a set;
wherein preparing said project definition comprises:
displaying a project window that includes a graphical representation of said project definition; and
allowing a user to modify said project definition by interacting with said graphical representation using a pointing tool; and
wherein execution of said project definition operates at least in part to manipulate a graphical aspect of said image data.

Applicants respectfully submit that *Kelly*, *O'Rourke*, and *Microsoft Corporation*, alone or in combination, fail to teach or suggest all elements of this claim.

Among other aspects of Claim 1, *Kelly*, *O'Rourke*, and *Microsoft Corporation*, alone or in combination, fail to teach or suggest:

- preparing a project definition that is operable when executed to process said image data . . .
- wherein preparing said project definition comprises:
 - displaying a project window that includes a graphical representation of said project definition; and
 - allowing a user to modify said project definition by interacting with said graphical representation using a pointing tool; and
- wherein execution of said project definition operates at least in part to manipulate a graphical aspect of said image data.

As teaching these elements, the *Final Office Action* relies upon various unrelated sections of *Kelly* and *O'Rourke*. First, the *Final Office Action* cites *Kelly*'s discussion of a structure converter and states that "the project [definition] is a structure converter between ODA and CDA." *Final Office Action* at p. 3. Then, the *Final Office Action* cites *O'Rourke*'s discussion of using icons to initiate execution of software programs. *Final Office Action* at p. 4 (citing *O'Rourke* at col. 1, ll. 30-40). However, Applicants respectfully submit that a structure converter used to convert documents between document architectures and using icons to initiate execution of software programs fail to teach or suggest the recited elements. For example, they fail to teach or suggest "preparing a project definition that is operable when executed to process said image data." They also fail to teach or suggest "allowing a user to modify said project definition by interacting with said graphical representation using a pointing tool." In addition, they fail to teach or suggest that "execution of said project definition operates at least in part to manipulate a graphical aspect of said image data." Furthermore, *Microsoft Corporation* also fails to teach or suggest these elements.

Kelly, *O'Rourke*, and *Microsoft Corporation*, alone or in combination, also fail to teach or suggest a "project definition including . . . a plurality of function portions." As teaching the project definition, the *Final Office Action* cites to *Kelly*'s discussion of a structure converter. Then, as teaching the plurality of function portions, the *Final Office Action* cites to a Document Application Profile (DAP). *Final Office Action* at p. 3. However, *Kelly* discloses that the "DAP contains a structure converter." *Kelly* at Abstract. Thus, the

Final Office Action cites to aspects of *Kelly* that are not arranged as required by Claim 1. For at least this reason, Applicants respectfully submit that *Kelly* fails to teach or suggest a “project definition including . . . a plurality of function portions.” Furthermore, *O’Rourke* and *Microsoft Corporation* also fail to teach or suggest this element.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the rejection of independent Claim 1. For analogous reasons, Applicants request reconsideration and withdrawal of the rejection of independent Claims 4, 7, and 14. The remaining claims depend from Claims 1, 4, 7, or 14 and therefore incorporate elements shown above to be allowable. Thus, for at least the same reasons discussed above, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of Claims 1-24.

In addition, various dependent claims present additional elements not taught or suggested by *Kelly*, *O’Rourke*, and *Microsoft Corporation*, either alone or in combination. Consider dependent Claims 21 and 22. For example, Claim 21 recites:

A method according to Claim 1, wherein:
said project window further includes a list of functions,
sources, and destinations; and
allowing said user to modify said project definition by
interacting with said graphical representation using said
pointing tool includes allowing said user to:
select at least one function, source, and
destination from said list;
indicate where to insert icons representing
selected functions, sources, and destinations in said graphical
representation; and
bind said icons inserted into said graphical
representation together.

As teaching these elements, the *Final Office Action* cites to multiple figures and a column of *O’Rourke* describing various aspects of Figure 3. *Final Office Action* at p. 8 (citing *O’Rourke* at Figs. 4, 6, 9 and col. 4, ll. 1-60). These figures depict graphical user interfaces associated with the invention disclosed in *O’Rourke*. In general, the graphical user interfaces provide “a convenient method for allowing a user to manage the application programs and files, initiate execution of application programs, [and] create associations between application programs and files.” *O’Rourke* at col. 3, ll. 22-25.

First, the *Final Office Action* cites to a portion of *O'Rourke* as teaching or suggesting "select[ing] at least one function, source, and destination from said list." *Final Office Action* at p. 8 (citing *O'Rourke* at col. 4, ll. 15-20). However, the portion of *O'Rourke* cited in the *Final Office Action* describes allowing a user to select a background image for the main screen of the graphical user interface. Applicants respectfully submit that selecting a background image for a graphical user interface fails to teach or suggest "select[ing] at least one function, source, and destination from said list."

Next, the *Final Office Action* cites to a portion of *O'Rourke* as teaching or suggesting "indicat[ing] where to insert icons representing selected functions, sources, and destinations in said graphical representation." *Final Office Action* at p. 8 (citing *O'Rourke* at col. 4, ll. 25-35). However, the portion of *O'Rourke* cited in the *Final Office Action* describes allowing a user to select a name and an icon for a "binder," which is a group of application programs. Applicants respectfully submit that selecting a name and an icon for a group of application programs fails to teach or suggest "indicat[ing] where to insert icons representing selected functions, sources, and destinations in said graphical representation."

Last, the *Final Office Action* cites to a portion of *O'Rourke* as teaching or suggesting "bind[ing] said icons inserted into said graphical representation together." *Final Office Action* at p. 8 (citing *O'Rourke* at col. 4, ll. 20-35). However, the portion of *O'Rourke* cited in the *Final Office Action* describes allowing a user to group application programs into the binders, or categories. Applicants respectfully submit that grouping application programs into categories fails to teach or suggest "bind[ing] said icons inserted into said graphical representation together."

For at least these reasons, Applicants respectfully submit that *Kelly*, *O'Rourke*, and *Microsoft Corporation*, either alone or in combination, fail to teach or suggest every element of dependent Claim 21. For analogous reasons, Applicants respectfully submit that *Kelly*, *O'Rourke*, and *Microsoft Corporation*, either alone or in combination, fail to teach or suggest every element of dependent Claim 22. Thus, for at least these reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of dependent Claims 21 and 22.

Also, Applicants point out that the *Final Office Action* fails to cite any reference with regard to various elements of dependent Claims 8, 15, 23, and 24. The *Final Office Action*

states that the various elements were “notoriously well known in the art at the time of the invention.” *See, e.g., Final Office Action* at p. 7 and 8. Applicants respectfully disagree, particularly when read in the context of the claims. Furthermore, to the extent that the Examiner maintains these assertions based on “Official Notice,” “well known prior art,” “common knowledge,” or other information within the Examiner’s personal knowledge, Applicants respectfully request that the Examiner cite a reference in support of these positions or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. § 1.104(d)(2).

B. There is No Teaching, Suggestion, or Motivation to Combine or Modify the Teachings of Kelly, O’Rourke, and Microsoft Corporation.

In addition, Applicants respectfully submit that Claims 1-24 are patentable over *Kelly, O’Rourke*, and *Microsoft Corporation* because there is no teaching, suggestion, or motivation to combine or modify the teachings of *Kelly, O’Rourke*, and *Microsoft Corporation* either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

The M.P.E.P. sets forth a strict legal standard for combining or modifying references. According to the M.P.E.P., “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. §2143.01. “The mere fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination” or modification. *Id.* (emphasis in original).

Governing Federal Circuit case law makes this strict legal standard even clearer. According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation . . . is an ‘essential component of an obviousness holding.’” *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998)). Furthermore, while “evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the

knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved, [t]he range of sources available . . . does not diminish the requirement for actual evidence.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Thus, it is a factual question that cannot be resolved on subjective belief and unknown authority, but must be based on objective evidence of record. *See In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002). Indeed, the factual inquiry whether to combine or modify references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001).

In the present case, the *Final Office Action* has not cited any evidence of a teaching, suggestion, or motivation to combine or modify the teachings of *Kelly*, *O’Rourke*, and *Microsoft Corporation*. Instead, the *Final Office Action* has merely stated that the teachings of one reference would improve the teachings of another reference. For example, with regard to the combination of *Kelly* and *O’Rourke*, the Examiner first states:

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a graphical user interface to manage the project and a pointing device as in *O’Rourke* because this would have represented a user-friendly solution to manipulating project information.

Final Office Action, at pp. 4, 6. Again with regard to the combination of *Kelly* and *O’Rourke*, the Examiner states:

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the graphical project management features of *O’Rourke* with *Kelly* to offer a user-friendly means of directing project structure in *Kelly*.

Final Office Action, at p. 8. Next, with regard to the combination of *Kelly*, *O’Rourke*, and *Microsoft Corporation*, the Examiner first states:

It would have been obvious to one of ordinary skill in the art at the time of the invention to have performed a translation in Microsoft Word in order to make foreign documents accessible in a word processor.

Final Office Action, at p. 9-10. The Examiner also states:

It would have been obvious to one of ordinary skill in the art at the time of the invention to have translated a document into text format in order to facilitate producing a text version of a complex file.

Id. at p. 10. In addition, the Examiner states:

It would have been obvious to one of ordinary skill in the art at the time of the invention to have imported and exported graphics in order to facilitate managing graphics for a complex file.

Id.

Applicants respectfully submit that these statements do not provide the required suggestion to combine. All of these statements represent the subjective belief of the Examiner, do not point to any known authority, and therefore are not based on objective evidence of record. Thus, the Examiner has not provided any evidence of a teaching, suggestion, or motivation to combine the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.


For this additional reason, Applicants respectfully submit that the claims are allowable over the cited references.

Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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